APPENDIX A — JUDGMENT AND OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DATED JANUARY 8, 2002

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

99-1421

TALBERT FUEL SYSTEMS PATENTS CO.,

Plaintiff-Appellant,

v.

UNOCAL CORPORATION,
UNION OIL COMPANY OF CALIFORNIA,

Defendants-Appellees,

and

TOSCO CORPORATION,

Defendant-Appellee.

JUDGMENT

ON APPEAL from the United States District Court for the Central District of California

In CASE NO(S). 98-CV-412

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED: AFFIRMED

Appendix A

ENTERED BY ORDER OF THE COURT

s/ Jan Horbaly
Jan Horbaly, Clerk

DATED: JAN 8 2002

ISSUED AS A MANDATE: March 22, 2002

Appendix A

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

99-1421

TALBERT FUEL SYSTEMS PATENTS CO.,

Plaintiff-Appellant,

v.

UNOCAL CORPORATION,
UNION OIL COMPANY OF CALIFORNIA,

Defendants-Appellees,

and

TOSCO CORPORATION,

Defendant-Appellee.

DECIDED: January 8, 2002

Before NEWMAN, MICHEL, and RADER, *Circuit Judges*.

NEWMAN, *Circuit Judge*.

Talbert Fuel Systems Patents Co. is the owner of United States Patent No. 5,015,356 (the '356 patent) entitled "Hydrocarbon Fuel Systems," inventor William Talbert. Defendant Union Oil Company of California (herein "Unocal" collectively with Unocal Corporation) owns United States Patent No. 5,288,393 (the '393 patent) entitled "Gasoline Fuel." Defendant Tosco is licensed under the '393 patent. Talbert appeals the district court's grant of summary judgment of noninfringement. Talbert also appeals the dismissal of its requested interference proceeding with the

'393 patent under 35 U.S.C. §291. We affirm the district court's dispositions.[1]

DISCUSSION

Talbert's '356 patent is directed to certain reformulated gasolines that reduce emissions while preserving key gasoline performance parameters. Gasolines are produced by refining crude petroleum, a process that includes distilling (fractionating) hydrocarbon mixtures that have been obtained by treating petroleum in various ways not here relevant. The characteristics of the resultant gasoline fractions are affected by their hydrocarbon composition. Conventional gasolines are complex mixtures of hydrocarbons having mostly four to twelve carbon atoms. Gasoline hydrocarbons are conventionally described in three groups or "cuts" based on the number of carbon atoms in the hydrocarbon molecules: C_4 and C_5 (low-end or front-end) hydrocarbons, C_6 to C_{10} (middle-cut), and C_{11} and C_{12} (high-end). The "cut" relates to the separation of hydrocarbon streams in the fractionation process.

The low-end and high-end hydrocarbons are of concern as sources of pollution, for low-end hydrocarbons vaporize readily and can enter the atmosphere uncombusted, for example at the gas pump, and high-end hydrocarbons may be incompletely combusted in the engine, thus polluting the

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1. *Talbert Fuel Systems Patents Co. v. Unocal Corporation*, No. 98-CV-412 (C.D. Cal. Dec. 15, 1998) (claim construction and dismissal of §291 claim); Apr. 12, 1999 (summary judgment of noninfringement for Unocal); May 3, 1999 (summary judgment of noninfringement for Tosco).

atmosphere through the exhaust. It was known that reduction of these components in gasoline is environmentally desirable. However, low-end hydrocarbons aid effective ignition, and high-end hydrocarbons provide fuel energy. Talbert's '356 patent is directed to reformulated gasolines that are substantially free of both low-end and high-end hydrocarbons, but with a calculated amount of low-end hydrocarbons added or retained as a "priming agent" to facilitate ignition.

Claim Construction

Claim construction is a matter of law, *see Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 970-71, 34 USPQ2d 1321, 1322 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370 (1996), and receives plenary review on appeal. *Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448, 1456, 46 USPQ2d 1169, 1172 (Fed. Cir. 1998) (*en banc*).

Claim 1 of the '356 patent is representative, with emphases added to indicate the terms whose construction is material to the issues of infringement:

> 1. A low Reid Vapor Pressure[2] liquid gasoline for use in a standard carbureted internal combustion engine; **said gasoline** comprising a priming agent and a hydrocarbon mixture having an intermediate carbon range relative to C_4-C_{12} fuel; **said intermediate carbon range consisting essentially of C_6-C_{10}** hydrocarbons with C_9 and C_{10}

2. Reid Vapor Pressure is a gasoline's vapor pressure in a sealed container at 100°F.

> paraffinic hydrocarbons being present in the mixture; **said gasoline having a boiling point range of 121-345°F** at 1 atmosphere pressure; and said priming agent consisting of a hydrocarbon selected from the group consisting of C_4 and C_5 hydrocarbons and mixtures thereof and said priming agent being present in a minimum effective amount for raising the front end volatility of the gasoline to a minimum level for cold engine starting with said minimum effective amount being less than that required for C_4-C_{12} gasoline.

The district court focused on the boiling point range of 121°F-345°F. The '356 patent explains that 121°F is the boiling point of the lowest-boiling C_6 component, 2,2-dimethylbutane (C_6H_{14}), and 345°F is the boiling point of decane, $C_{10}H_{22}$, the highest-boiling C_{10} component. The district court construed claim 1 as limited to gasolines having a final boiling point of 345°F, and excluding gasolines having a higher final boiling point.

Talbert argues that the district court erred in defining 345°F as a final boiling point, pointing out that the word "final" does not appear in claim 1. Talbert argues that some higher boiling hydrocarbons can be present, such as C_{11} and C_{12} hydrocarbons, due to the generally recognized imprecision of the refining process, which does not produce gasolines of specific hydrocarbon composition with precise end points. Talbert explains that refinery distillation produces cuts of distillate which may include hydrocarbon components that when pure boil above or below the range of the refinery cut. The '393 patent explains that a refinery stream cut at

345°F will contain "a small amount" of hydrocarbons boiling above 345°F and having 11-12 carbons.

Talbert states that the claim term "consisting essentially of C_6-C_{10}" recognizes that gasoline in the 121°-345°F boiling range contains mostly C_6 to C_{10} hydrocarbons, but that some hydrocarbons outside that range can be present. Talbert argues that since some hydrocarbons higher than C_{10} can be present, they necessarily would raise the final boiling point of the gasoline above 345°F. Talbert argues that claim 1 is not limited to gasolines whose final boiling point is 345°F because even traces of hydrocarbons above C_{10} will raise the final boiling point above 345°F, without significantly altering the fuel's performance for standard carbureted engines. Thus Talbert urges that when reading the claim as a whole including its preamble, taking cognizance of the imprecision of refinery methods, a claim construction is required that does not limit the boiling point of the gasoline to 345°F.

The basic tools of claim construction are the words of the claim, understood in light of the specification and the prosecution history, in accordance with the usage and knowledge in the field of the invention. A term of technical art, unless defined otherwise, by the patentee, has the meaning by which it would be understood by persons experienced in the field of the invention. *See, e.g., Multiform Dessicants v. Medzam*, 133 F.2d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998).

The district court, rejecting Talbert's proposed construction, ruled that claim 1 is limited to gasolines whose final boiling point is 345°F. In doing so, the district court

focused on the "explicit limitation" in the clause "said gasoline having a boiling point range of 121°-345°F." We agree with the district court that the plain meaning of a boiling point range that is used to define a composition and distinguish it from other compositions is that the range limits the composition to that stated in the claim, and that compositions of a different boiling range are not covered by the claim. While the signal "consisting essentially of" allows for the presence of small amounts of components outside of the designated paraffinic C_6-C_{10} hydrocarbons, the boiling range of 121°-345°F is designated as describing the entire claimed gasoline. The phrase "consisting essentially of" thus cannot negate the limiting effect of the claimed temperature range of 121°-345°F, a limitation added in acquiescence to the examiner's requirement for specificity. Thus, Talbert's argument that the recited range does not exclude gasolines with a higher upper temperature is untenable.

During prosecution Talbert stressed that 345°F was the "final boiling point" for standard carbureted gasoline as well as for the gasifier gasoline of Talbert's original application. Talbert told the examiner: "Furthermore, it will be noted that applicant's fuel which contains C_9 and C_{10} hydrocarbons has a final boiling point of 345° which corresponds to the boiling point of C_{10} paraffinic hydrocarbon." Although Talbert argues that this statement was not intended to limit the boiling point of the claimed gasoline, but simply to highlight that the newly added description "paraffinic hydrocarbons" was not new matter under 35 U.S.C. §112, Talbert consistently stated during prosecution that its fuel has a final boiling point of 345°F.

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Talbert also relied on the 345°F upper limit to distinguish various references during prosecution of the '356 application. For example, in discussing Hamilton Patent No. 3,002,917, Talbert stated that "the temperature range of the boiling points of the hydrocarbons of the gasoline of the presently claimed invention is between 96.8° and 345°F. There is absolutely no suggestion of such a gasoline composition in the Hamilton reference." Talbert also argued that Hamilton "teaches away from [the claimed] fuel by providing for a fraction having a boiling range up to 390°F (column 1, lines 42-43). This fraction is not the same as, nor equivalent to, that which is the subject of applicant's composition claims." Talbert also stated that "fuel having hydrocarbon components with boiling points above those claimed" would function in a manner that "completely negate[s] an important characteristic of the composition of the invention." Although Talbert now argues that Hamilton's high-octane aviation gasoline differs in several ways from that of Talbert, and that Talbert was not required to recite all the differences from Hamilton during prosecution, nonetheless Talbert emphasized the difference in boiling point ranges as the distinction on which he premised patentability.

Again, in distinguishing the Schulze 2,409,157 patent, Talbert stressed his "final boiling point of 345° which corresponds to the boiling point of C_{10} paraffinic hydrocarbon," and also the limitation of the C_9-C_{10} hydrocarbons to paraffinic hydrocarbons. Talbert argues that Schulze is directed to an aviation gasoline containing a high proportion of aromatic hydrocarbons, and that Schulze was distinguished by Talbert's inclusion of the paraffinic limitation in the claims. While that is an accurate description

of the prosecution, Talbert also emphasized, for Schulze as well as for Hamilton, that 345°F marked the upper boiling point of the Talbert claimed gasoline. Even if such a precise limit was not necessary for patentability, as Talbert now argues, it is explicitly stated in the claims. Thus we confirm the district court's conclusion that the upper boiling temperature limit for the gasoline defined in claim 1 is 345°F.

Talbert states that this claim construction is incorrect because it is inoperable. We agree that a construction that renders the claimed invention inoperable should be viewed with extreme skepticism. *See generally Modine Mfg. Co. v. United States Int'l Trade Comm'n*, 75 F.3d 1545, 1557, 37 USPQ2d 1609, 1617 (Fed. Cir. 1996) ("When claims are amenable to more than one construction, they should when reasonably possible be interpreted so as to preserve their validity."). However, Talbert did not demonstrate inoperability or provide any basis for judicially interpreting the claim to adjust the temperature range that Talbert states is the inoperable limitation.

Talbert also states that the district court's construction of the claim excludes the preferred embodiment. *See Hoechst Celanese Corp. v. BP Chem. Ltd.*, 78 F.3d 1575, 1581, 38 USPQ2d 1126 (Fed. Cir. 1996) ("it is unlikely that an inventor would define the invention in a way that excluded the preferred embodiment, or that persons of skill in this field would read the specification in such a way"). Again, Talbert has not supported this argument. It does not contradict the specification's teaching that refinery distillations are imprecise, to apply the specification's teaching and the prosecution history's argument that the upper temperature limit of the gasoline is 345°F.

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We confirm the district court's claim construction. On this construction Talbert conceded that there was not literal infringement; we have been directed to no contradiction of Unocal's statements that its production records show "true boiling point endpoints ranging from 373.8°F up to 472.9°F."

The Doctrine of Equivalents

The district court granted Unocal's summary judgment motion that there was no infringement under the doctrine of equivalents. Summary judgment may be granted on the factual question of equivalency when the nonmovant cannot prevail, even when resolving disputed facts and drawing all factual inferences in its favor. *See EMI Group v. Intel Corp.*, 157 F.3d 887, 891, 48 USPQ2d 1181, 1184 (Fed. Cir. 1998). The district court ruled that Talbert had "surrendered claims to a fuel with a boiling point in excess of 345°," and thus that Talbert was estopped to reach a fuel with a higher boiling range, under the doctrine of equivalents.

As we have discussed, to overcome the Hamilton reference Talbert argued that the Hamilton gasoline, a high-octane aviation fuel having a boiling range up to 390°F, is "not the same as, nor equivalent to" the claimed gasoline. Talbert states that this argument concerning Hamilton does not support a surrender of all higher boiling gasolines. Talbert states that the 121°-345°F temperature range was included in response to the examiner's requirement for specificity, not to overcome prior art. However, the prosecution record shows that Talbert relied on this temperature specificity for patentability purposes. *See Warner-Jenkinson Co. v. Hilton*

Davis Chemical Co., 520 U.S. 17, 30 (1997). We agree with the district court that Talbert is estopped to reach, by way of equivalency, Unocal's gasoline having a significantly higher boiling range. *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 56 USPQ2d 1986 (Fed. Cir. 2000) (*en banc*), *cert. granted*, 121 S. Ct. 2519 (No. 00-1543) (U.S. June 18, 2001).

The grant of summary judgment of noninfringement under the doctrine of equivalents is affirmed.

The Requested Interference Proceeding

Talbert states that it disclosed its invention to Unocal in 1989, that Unocal evaluated the invention and stated that it was not interested, and then a year later filed its own patent application (which issued as the '393 patent) on what Talbert states is substantially the same invention. The '393 patent's claim 81 follows, edited to include the limitations of the claims from which it depends:

> 81. An unleaded gasoline fuel [suitable for combustion in a spark ignition automotive engine, said fuel having an octane value of at least 92, a 50% D-86 distillation point no greater than 200°F, and a Reid Vapor Pressure no greater than 7.0 psi] and a 90% D-86 distillation point no greater than 300°F.

Talbert sought resolution in the district court of whether claim 81 of the Unocal '393 patent and claim 1 of the Talbert '356 patent are directed to the same invention, and a declaration

of priority of invention in accordance with the procedures of 35 U.S.C. §291:

> §291 The owner of an interfering patent may have relief against the owner of another by civil action, and the court may adjudge the question of the validity of any of the interfering patents, in whole or in part. The provisions of the second paragraph of section 146 of this title shall apply to actions brought under this section.

When patents are deemed "interfering" under §291, the district court determines priority of invention and may declare invalid any claim that loses the priority determination. Thus the necessary predicate to an interference under §291 is identity of the invention as claimed by each party. *See Advance Transformer Co. v. Levinson*, 837 F.2d 1081, 1084, 5 USPQ2d 1600, 1602 (Fed. Cir. 1988) ("interfering patents are patents that claim the same subject matter").

The district court denied Talbert's request for a §291 interference, on the ground that the inventions are not the same. The court found that the challenged claims of Unocal's '393 patent do not state a similar boiling point limit, and that "the '393 patent's specific olefin and paraffin limitations further distinguish it from the composition prescribed by the '356 patent." Thus the district court found that no interference existed.

Talbert argues that the '356 claims should not be read to include a temperature restriction; this argument fails, as we have discussed. Talbert also argues that Talbert's claim 1 and

Unocal's claim 81 define the same gasoline, but simply recite different characteristics. For example, Talbert states that Unocal's claimed properties of a 50% distillation point at or below 200°F, a 90% distillation point at or below 300°F, and a Reid Vapor Pressure no greater than 7.0, also exist in Talbert's claimed gasoline. Unocal in turn argues that several of the limitations in Talbert's claim 1 do not apply to Unocal's claim 81, such as the temperature limit of 345°F and the recitation of paraffin hydrocarbons. Unocal maintains that the properties stated in Unocal's claim 81 are not inherent in the gasoline of Talbert's claim 1 because gasoline covered by claim 1 will not always possess the properties set forth in claim 81.

Talbert is correct that interfering claims need not recite all of the same limitations, if in fact the claims cover the same subject matter. Talbert provided affidavits of David Hirshfield, described as a leading expert in gasoline technology, and of the inventor William Talbert, that a gasoline in accordance with claim 1 of the '356 patent would have the characteristics recited in claim 81 of the '393 patent. However, neither affiant substantiated this view or challenged Unocal's response that the Talbert fuel did not meet the claim 81 requirement of an octane value of at least 92.0. The Hirshfield affidavit states that "the octane value of the Talbert gasoline sample is only 84.3" and that additives were used to raise Talbert's octane to 92.

It is apparent that the octane value required by Unocal's claim 81 is not possessed by Talbert's gasoline of claim 1, but is available only by manipulation of the composition using octane-increasing additives. As explained in *Continental Can*

Co. v. Monsanto Co., 948 F.2d 1264, 1269, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991), discussing inherency in the context of obviousness:

> Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. [Citations omitted.] If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

(quoting *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)). Accepting Talbert's expert testimony that one skilled in the art would have known how to raise the Talbert gasoline's octane value does not convert Talbert's claimed gasoline into one having a higher octane value. Talbert's affidavit evidence is insufficient as a matter of law to establish identity of subject matter. We affirm the district court's decision declining to declare an interference under §291.

AFFIRMED.

No costs.

APPENDIX B — ORDER OF THE UNITED STATES DISTRICT COURT FOR THE CENTRAL DISTRICT OF CALIFORNIA, WESTERN DIVISION DATED AND FILED OCTOBER 27, 1999

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
WESTERN DIVISION

Case No. CV 98-0412 CBM

TALBERT FUEL SYSTEMS PATENTS CO.

Plaintiff,

v.

UNOCAL CORP., UNION OIL COMPANY OF CALIFORNIA, and TOSCO CORPORATION

Defendants.

ORDER GRANTING PLAINTIFF'S MOTION TO DISMISS DEFENDANT'S COUNTERCLAIMS AND RELATED AFFIRMATIVE DEFENSES WITHOUT PREJUDICE ON THE CONDITION THAT THEY MAY BE REINSTATED IF THE FEDERAL CIRCUIT REVERSES THE APRIL 13, 1999 AND MAY 1999 ORDERS

The matter before the Court is Plaintiff's motion regarding final judgment. Upon consideration of the papers submitted, the Court GRANTS Plaintiff's motion to dismiss Defendant's counterclaims and related affirmative defenses without prejudice on the condition that they may be reinstated if the Federal Circuit reverses the April 13, 1999 and May 1999 order.

Appendix B

I. BACKGROUND

On January 16, 1998, Plaintiff Talbert filed suit alleging that Defendants Unocal and Tosco infringed on its '356 patent. Talbert also alleged that the '393 patent, which was assigned to Unocal, was an interfering patent with the '356 patent pursuant to 35 U.S.C. § 291, and asked the Court to find the '393 patent invalid.

On February 17, 1998, Unocal answered the complaint and filed a counterclaim against Talbert, seeking a declaration of non-infringement and invalidity of the '356 patent, and a declaration that Talbert is equally estopped from asserting the '356 patent against Unocal. On March 4, 1998 and as amended on October 20, 1998, Tosco answered and filed an amended counterclaim against Talbert seeking a declaration of non-infringement and invalidity of the '356 patent, and equitable estoppel.

On December 15, 1998 the Court issued an order construing the claims of the '356 patent in suit and dismissing Count III of the Complaint (interference claim against Unocal). On April 13, 1999 the Court granted Unocal and Union Oil summary judgment of non-infringement and dismissed the complaint. On May 5, 1999 the Court granted Tosco summary judgment of non-infringement and dismissed the complaint.

Plaintiff Talbert believes that the orders have mooted the topic of patent validity and consequently, on May 19, 1999, filed a notice of appeal with the Federal Circuit, who has exclusive jurisdiction over patent appeals, to obtain review of the April and May 1999 orders. The appeal was docketed on June 9, 1999, and Talbert's appeal brief was due on August

9, 1999. Defendant Tosco has also filed a motion with the Federal Circuit, asking the Circuit to dismiss Talbert's appeal because the Federal Circuit lacks jurisdiction pursuant to 28 U.S.C. § 1295 because there is no final judgment. Defendant Tosco served discovery requests regarding patent validity on June 14, 1999.

Talbert here moves for the dismissal of Defendant's counterclaims and related affirmative defenses without prejudice on the condition that they may be reinstated if the Federal Circuit reverses the April 13, 1999 and May 1999 orders. Talbert asserts that both orders rely on the December 15, 1998 order.

In the alternative, Talbert moves pursuant to Rule 54(b) of the Federal Rules of Civil Procedure for an order that the April 13, 1999, May 5, 1999, and December 15, 1998 orders are a final judgment as to fewer than all of the claims "based on an express determination that there is no just reason for delay and with an express direction for the entry of judgment." Talbert also moves, if the Court chooses this alternative, for a stay of Tosco's discovery requests[1] served on June 14, 1999 regarding the validity of Talbert's patent.

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1. The requests include interrogatories, requests for admission, and requests for production.

Appendix B

II. DISCUSSION

A. Plaintiff Talbert's motion for dismissal of Defendant's counterclaims and affirmative defenses without prejudice

The Supreme Court has counseled that the better approach is for courts to inquire into both non-infringement and invalidity in order to prevent piecemeal litigation and to increase judicial efficiency.

> There has been a tendency among the lower federal courts in infringement suits to dispose of them where possible on the ground on non-infringement without going into the question of validity of the patent. [Citations to circuit court decisions omitted.] It has come to be recognized, however, that of the two questions, validity has the greater public importance, [citation omitted] and the District Court in this case followed what will usually be the better practice by inquiring fully into the validity of [the] patent.

Sinclair & Carroll Co. v. Interchemical Corp., 325 U.S. 327, 330 (1945). More recently, the Supreme Court stated that the dispositive distinction is whether the validity claim is found in an affirmative defense or in a counterclaim for declaratory judgment, and indicated that on appeal it is necessary to resolve a counterclaim for declaratory judgment. *Cardinal Chemical Co. v. Morton Int'l, Inc.*, 508 U.S. 83, 100, 93-94 (1993). However, the Court noted that the issue in *Cardinal* was the jurisdiction of an intermediate appellate

court, not the jurisdiction of a trial court, and reaffirmed that "the Declaratory Judgment Act affords the district court some discretion in determining whether or not to exercise that jurisdiction, even when it has been established." *Id.* at 94 n.17.

Indeed, the Federal Circuit has held that a trial court has the "discretion to dismiss a counterclaim alleging that a patent is invalid as moot where it finds no infringement." *Phonometrics, Inc. v. Northern Telecom, Inc.*, 133 F.3d 1459, 1468 (Fed.Cir.1998). *See also Nestier Corp. v. Menasha Corp.-Lewisystems Div.*, 739 F.2d 1576, 1580-81 (Fed.Cir. 1984). The Federal Circuit has noted that "[t]he residual possibility or a future infringement suit based on [the declaratory plaintiff's] future acts is simply too speculative a basis for jurisdiction over [its] counterclaim for declaratory judgments of invalidity." *Super Sack Manufacturing Corp. v. Chase Packaging Corp.*, 57 F.3d 1054, 1059-60 (Fed. Cir. 1995).

Note, however, that the Federal Circuit has also stated that a district court should decide non-infringement and invalidity when both issues are before the court. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1540-41 (Fed. Cir. 1983); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1463-64 (Fed. Cir. 1984) ("To enter judgment on less than all dispositive issues can be inefficient, risking as it does the necessity of the district court and the parties undertaking participation in another long and costly proceeding.")

Appendix B

Plaintiff Talbert argues that the determination of non-infringement moots the issue of patent validity that Tosco presented as a counterclaim. Talbert asserts that there is no just reason for delay.

Defendant Unocal agrees to and prefers dismissal without prejudice, subject to reinstatement if the orders are reversed.

Defendant Tosco asserts that regardless of the outcome of an appeal of the noninfringement rulings, the counterclaims are not moot because an ongoing controversy exists over the validity of the '356 patent.[2] Tosco asserts that a finding of invalidity will end the ongoing conflict while a finding of non-infringement will not. Talbert replies that Tosco fails to present any facts supporting its statement that Tosco "necessarily faces continued conflict with Talbert." Talbert asserts that the Court has determined that all of Tosco's CARB certified reformulated gasolines that could be accused of infringing the '356 patent to be non-infringing.

It appears that the decision to dismiss is a discretionary one. This Court GRANTS Plaintiff's motion to dismiss Defendant's counterclaims and related affirmative defenses

2. Specifically, Tosco asserts that Tosco is a major supplier of reformulated low emission gasolines which meet the California Air Resources Board ("CARB") requirements, and that Talbert has represented that its '356 patent covers reformulated (CARB) certified gasolines. Tosco asserts that since Talbert has sued Tosco for alleged infringement, and may assert the '356 patent in the future, a continuing conflict exists. Tosco asserts that Unocal is in a different position because Unocal no longer manufactures or sells the accused reformulated CARB certified gasolines, and so has no desire to invalidate Talbert's patent.

without prejudice on the condition that they may be reinstated if the Federal Circuit reverses the April 13, 1999 and May 1999 orders. *See Phonometrics, Inc. v. Northern Telecom, Inc.*, 133 F.3d 1459, 1468 (Fed. Cir. 1998); *Nestier Corp. v. Menasha Corp.-Lewisystems Div.*, 739 F.2d 1576, 1580-81 (Fed. Cir. 1984); *Super Sack Manufacturing Corp. v. Chase Packaging Corp.*, 57 F.3d 1054, 1059-60 (Fed. Cir. 1995). No ruling on the alternative motion pursuant to Rule 54(b) is necessary based on this Court's findings and granting of Plaintiff's motion to dismiss.

IT IS SO ORDERED.

DATE: October 27, 1999

s/ Consuelo B. Marshall
CONSUELO B. MARSHALL
UNITED STATES DISTRICT JUDGE

APPENDIX C — ORDER OF THE UNITED STATES DISTRICT COURT FOR THE CENTRAL DISTRICT OF CALIFORNIA, WESTERN DIVISION DATED MAY 3, 1999, FILED MAY 4, 1999 AND ENTERED MAY 5, 1999

* * *

IN THE UNITED STATES DISTRICT COURT
FOR THE CENTRAL DISTRICT OF CALIFORNIA
WESTERN DIVISION

Civil Action No. 98-0412 KMX (RNBx)

TALBERT FUEL SYSTEMS PATENTS CO.,

Plaintiff,

v.

UNOCAL CORPORATION, UNION OIL COMPANY OF CALIFORNIA, and TOSCO CORPORATION,

Defendants.

AND RELATED CROSS ACTIONS

ORDER [PROPOSED] GRANTING TOSCO CORPORATION'S MOTION FOR SUMMARY JUDGMENT OF NONINFRINGEMENT

WHEREAS, on April 13, 1999, the Court entered an Order Granting Defendants Unocal Corporation's and Union Oil Company of California's ("Unocal") Motion for Summary Judgment of Noninfringement of U.S. Patent No. 5,015,356 ("the '356 patent") asserted by Plaintiff Talbert Fuel Systems Patents Co. ("Talbert"); and

Appendix C

WHEREAS, Talbert and Defendant Tosco Corporation ("Tosco") have entered into a Stipulation, attached as Exhibit A, pursuant to which Tosco has moved for Summary Judgment of Noninfringement of the '356 patent.

NOW, THEREFORE, in view of the parties' Stipulation and the Order entered April 13, 1999 granting Unocal's Motion for Summary Judgment of Noninfringement,

IT IS HEREBY ORDERED that Tosco's Motion for Summary Judgment of Noninfringement of the '356 patent is granted and the Court's April 13, 1999 ruling of noninfringement is hereby extended to include Tosco as well as Unocal.

Dated: MAY 3 1999

s/ Consuelo B. Marshall
Hon. Consuelo B. Marshall
UNITED STATES DISTRICT JUDGE

* * *

APPENDIX D — STIPULATION AND ORDER OF THE UNITED STATES DISTRICT COURT FOR THE CENTRAL DISTRICT OF CALIFORNIA, WESTERN DIVISION DATED APRIL 28, 1999 AND APRIL 29, 1999

* * *

IN THE UNITED STATES DISTRICT COURT
FOR THE CENTRAL DISTRICT OF CALIFORNIA
WESTERN DIVISION

Civil Action No. 98-0412 CMB (RNBx)

TALBERT FUEL SYSTEMS PATENTS CO.,

Plaintiff,

v.

UNOCAL CORPORATION, UNION OIL COMPANY OF CALIFORNIA, and TOSCO CORPORATION,

Defendants.

AND RELATED CROSS ACTIONS

STIPULATION AND ORDER [PROPOSED]
RE MOTION FOR SUMMARY JUDGMENT
OF NONINFRINGEMENT BY
TOSCO CORPORATION

WHEREAS, on April 13, 1999, the Court entered an Order Granting Defendants Unocal Corporation's and Union Oil Company of California's ("Unocal") Motion for Summary Judgment of Noninfringement;

Appendix D

WHEREAS, Plaintiff Talbert Fuel Systems Patents Co. ("Talbert") has admitted that Defendant Tosco Corporation's ("Tosco") gasoline accused of infringement is the same as the Unocal gasoline accused of infringement insofar as the Tosco gasoline does not have both an RVP between 6 psi and 9 psi and a final true boiling point less than or equal to 345°F; and

WHEREAS, Talbert has further admitted that the accused Tosco gasoline, like the accused Unocal gasoline, does not literally infringe any claims of U.S. Patent No. 5,015,356 as those claims were construed by the Court in its Order entered December 15, 1998.

NOW, THEREFORE, to efficiently resolve the issue of infringement under the doctrine of equivalents with respect to Tosco, Talbert and Tosco hereby stipulate that:

1. Tosco moves the Court for summary judgment of noninfringement in favor of Tosco on the same grounds stated in Unocal's Motion for Summary Judgment of Noninfringement.

2. Talbert opposes Tosco's motion on the same grounds stated in Talbert's Opposition to Unocal's Motion.

3. Tosco's motion is submitted for ruling by the Court. Tosco will concurrently lodge for the Court's consideration a Proposed Order granting Tosco's Motion and extending the Court's April 13, 1999 ruling of noninfringement to include Tosco as well as Unocal.

4. This Stipulation is without waiver of or prejudice to any and all rights of appeal.

Appendix D

IT IS SO STIPULATED:

RONALD L. ENGEL
c/o JOHNSON BELL, LTD.

Dated: 4/29/99

By: s/ Ronald L. Engel
Ronald L. Engel
Attorneys for Plaintiff
and Counterdefendant
TALBERT FUEL SYSTEMS
PATENTS CO.

KNOBBE, MARTENS, OLSON
& BEAR, LLP

Dated: 4/28/99

By: s/ James F. Lesniak
James F. Lesniak
Craig S. Summers
John P. Giezentanner
Attorneys for Defendant
and Counterclaimant
TOSCO CORPORATION

IT IS SO ORDERED:

Dated: _____

_____
Hon. Consuelo B. Marshall
UNITED STATES
DISTRICT JUDGE

APPENDIX E — ORDER OF THE UNITED STATES DISTRICT COURT FOR THE CENTRAL DISTRICT OF CALIFORNIA DATED APRIL 6, 1999, FILED APRIL 12, 1999 AND ENTERED APRIL 13, 1999

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

Civil Action No. 98-0412 CMB (RNBx)

TALBERT FUEL SYSTEMS PATENTS CO.,

Plaintiff,

v.

UNOCAL CORPORATION, UNION OIL COMPANY OF CALIFORNIA, and TOSCO CORPORATION,

Defendants.

UNOCAL CORPORATION and UNION OIL COMPANY OF CALIFORNIA, and TOSCO CORPORATION,

Counterclaimants

v.

TALBERT FUEL SYSTEMS PATENTS CO.,

Counterdefendant.

The matter before the Court is Defendants Unocal Corporation ("Unocal") and Union Oil's ("Union") Motion for Summary Judgment. On March 22, 1999 the parties appeared before the Court, the Honorable Consuelo B.

Marshall, United States District Judge, presiding. Upon consideration of the papers submitted and the arguments of counsel, the Court GRANTS Defendants' Motion.

I. BACKGROUND

Plaintiff, Talbert Fuel Systems, is the owner of US Patent No. 5,015,356 ("the '356 patent"), which issued May 14, 1991. Defendant Unocal is the owner by assignment of the US Patent No. 5,288,393 ("the '393 patent"), which issued February 22, 1994. Both patents cover formulas for making reformulated gasoline.

The concept behind both patents is a method for creating a reformulated gasoline that retains all of the performance aspects of conventional gasoline but reduces polluting emissions. Conventional gasoline consists of a mixture of hydrocarbons ranging from C4 to C12. The parties' reformulated gasolines attempt to reduce the amount of low and high end hydrocarbons in order to reduce volatility and emissions. Low end carbons are quite volatile, but are added to fuel as "primers" to aid engine performance and ensure the starting of cold engines. The volatility of these carbons leads to evaporative and emission losses and thus - pollution.[1] The higher end or heavyweight hydrocarbons are included in traditional gasolines because producers have previously believed that their presence is necessary to provide a fuel having "suitable properties" for automotive use.

1. Reid Vapor Pressure is the measurement of gasoline volatility. Both parties agree that current fuels include too many volatile components which raise the Reid Vapor Pressure to undesirable levels.

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These heavyweight components also contribute to pollution because they take longer to burn and/or burn too hot, producing high levels of nitrous oxides. (See Exhibit F, Pl's Appendix, pp. 315-320).

Unocal's '393 patent and Talbert's '356 patent both cover a formula for gasoline containing reduced low and high end hydrocarbons and concentrating the middle weight (C6-C10) hydrocarbons to produce a high performance and "environmentally friendly" gasoline.

On March 1, 1996, the California Air Resources Board established regulations mandating the use of reformulated or so-called "Phase 2" gasoline in California in order to reduce air pollution. Unocal was in the business of making, using, selling and offering for sale this reformulated gasoline (the '393 patent formula). On December 14, 1996, Unocal sold its business of refining and marketing reformulated gasolines to Tosco. Unocal retained the '393 patent and granted Tosco a license under the '393 patent to manufacture this reformulated gasoline.

On April 30, 1997, Talbert Fuel Systems, Inc., believing that Defendants were manufacturing gasoline that infringed the '356 patent, sent letters to Defendants Unocal and Tosco offering licenses of the '356 patent. Neither of the defendants responded to the letter. On January 16, 1998, Talbert filed the instant action alleging three claims: (1) Direct Patent Infringement by Unocal; (2) Direct Patent Infringement by Tosco; and (3) Interfering Patents. On February 17, 1998 Unocal filed an answer and a counterclaim for declaratory judgment seeking a determination that the '356 patent is invalid and that Talbert is estopped from attempting to collect royalties under the '356 patent against Unocal. On March 4, 1998, Tosco filed an answer and counterclaim seeking identical declaratory and injunctive relief and requesting a jury trial.

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On December 15, 1998, this Court granted the parties' request for limited claim construction of the '356 patent. Based upon that construction, the court found that the '356 and '393 patents were not interfering patents and accordingly granted Defendant's Motion to Dismiss Plaintiff's Third Claim for Relief. On March 1,1999, Defendants filed the instant motion for summary judgment.

III. DISCUSSION

A. Summary Judgment Standard

Summary judgment may be granted when "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). In a motion for summary judgment, "[i]f the party moving for summary judgment meets its initial burden of identifying for the court those portions of the materials on file that it believes demonstrates the absence of any genuine issues of material fact," the burden of production then shifts so that the non-moving party must set forth, by affidavit or as otherwise provided in Rule 56, "specific facts showing that there is a genuine issue for trial." *T.W. Elec. Serv. Inc. v. Pacific Elec. Contractors Ass'n*, 809 F.2d 626, 630 (9th Cir. 1987) (quoting *Celotex Corp. v. Catrett*, 477 U.S. 317, 324 (1986)); *Kaiser Cement Corp. v. Fishbach & Moore, Inc.*, 793 F.2d 1100, 1103-1104 (9th Cir. 1986), *cert. denied*, 479 U.S. 949 (1986).

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If the non-moving party bears the burden of proof with respect to an element essential to the case, and that party fails to make a sufficient showing to establish a genuine dispute of fact with respect to the existence of the element, summary judgment is appropriate. *California Architectural*, 818 F.2d at 1468 (citing *Celotex*, 477 U.S. at 317).

B. Plaintiff's Claim for Infringement Under the "Doctrine of Equivalents"

Plaintiff concedes that Unocal's '393 patent does not literally infringe Talbert's '356 patent. Plaintiff argues instead that the '393 patent infringes the '356 under the "doctrine of equivalents." Even if a court finds that there is no literal infringement, a patentee may offer proof of infringement under the doctrine of equivalents if the accused product "performs substantially the same function in substantially the same way to obtain the same result." *Multiform Dessicants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1480 (Fed. Cir. 1998). Before assessing the issue of technological similarity, however, a court must first determine whether there is any "estoppel derived from the prosecution history that bars remedy even when there is technologic equivalency." *Id.* This prosecution history estoppel precludes the patentee from reaching, under the doctrine of equivalents, subject matter that was disclaimed in order to obtain the patent. *Id.*; *see also Bai v. L&L Wings, Inc.*, 160 F.3d 1350, 1356 (Fed. Cir. 1998); *Depser Products Inc. v. Osound Labs. Inc.*, 157 F.3d 1325, 1338 (Fed. Cir. 1998).

Talbert emphasizes that, to determine whether an estoppel exists to limit the doctrine of equivalents, the court

must engage in a different inquiry than that which guided the claim construction analysis. This may generally be true; however, in construing the relevant claims of the '356 patent, this court found that "Talbert distinguished his fuels from prior art by highlighting that his middle cut gasoline blend had a final boiling point of 345°." (Dec. 15 Order, 5:16-18) Talbert's opposition to the instant motion essentially repeats the arguments that were made and rejected in the context of the claim construction of the '356 patent. These arguments carry no greater force in opposing this motion because the court has already determined that, in order to distinguish the '356 patent from prior art, Talbert surrendered claims to a fuel with a boiling point in excess of 345°. "[A] patentee, after relinquishing subject matter to distinguish a prior art reference asserted by the PTO during prosecution 'cannot during subsequent litigation escape reliance [by the defendant] upon this unambiguous surrender of subject matter.' " *Spectrum Int'l, Inc. v. Sterilite Corp.*, 164 F.3d 1372, 1379 (Fed. Cir. 1998) (quoting *Southwall Techs. Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576 (Fed. Cir. 1995)). Talbert is therefore estopped from arguing that a fuel with an endpoint above 345°F infringes the '356 patent under the doctrine of equivalents.

Based on the foregoing, the court GRANTS Defendants' Motion for Summary Judgment on Claims 1 and 2..

IT IS SO ORDERED.

DATE: 4/6/99

s/ Consuelo B. Marshall
CONSUELO B. MARSHALL
UNITED STATES DISTRICT JUDGE

APPENDIX F — ORDER OF THE UNITED STATES DISTRICT COURT FOR THE CENTRAL DISTRICT OF CALIFORNIA DATED DECEMBER 11, 1998, FILED DECEMBER 14, 1998 AND ENTERED DECEMBER 15, 1998

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

Case No. CV 98-0412 CMB (RNBx)

TALBERT FUEL SYSTEMS PATENTS CO.,

Plaintiff,

v.

UNOCAL CORPORATION, UNION OIL COMPANY OF CALIFORNIA, and TOSCO CORPORATION,

Defendants.

UNOCAL CORPORATION and UNION OIL COMPANY OF CALIFORNIA, and TOSCO CORPORATION,

Counterclaimants

v.

TALBERT FUEL SYSTEMS PATENTS CO.,

Counterdefendant.

ORDER GRANTING PARTIES' REQUEST FOR CLAIM CONSTRUCTION AND GRANTING DEFENDANTS' MOTION TO DISMISS

The matters before the Court are; (1) Defendants' Motion for limited claim construction; (2) Defendants' 12(b)(1)

motion to dismiss; and (3) Plaintiff's Motion for claim construction. On November 23, 1998, the parties came before the Court, the Honorable Consuelo B. Marshall, United States District Judge, presiding. Upon consideration of the papers submitted and the arguments of counsel, the Court GRANTS the parties' request for a claim construction of Talbert's '356 patent and, based upon that construction, GRANTS Defendants' Motion to DISMISS WITH PREJUDICE Talbert's third claim for interfering patents.

I. BACKGROUND

Plaintiff, Talbert Fuel Systems, is the owner of US Patent No. 5,015,356 ("the '356 patent"), which issued May 14, 1991. Defendant Unocal is the owner by assignment of the US Patent No. 5,288,393 ("the '393 patent"), which issued February 22, 1994. The same examiner presided over the prosecution of Talbert's '356 patent and Unocal's '393 patent, and Unocal actually submitted the '356 patent to the examiner; however, the examiner never raised Talbert for either obviousness or anticipation during the prosecution of Unocal's patent.

The concept behind both patents is a method for creating a reformulated gasoline that retains all of the performance aspects of conventional gasoline but reduces polluting emissions. Conventional gasoline consists of a mixture of hydrocarbons ranging from C4 to C12. The parties' reformulated gasolines attempt to reduce the amount of low and high end hydrocarbons in order to reduce volatility and emissions.

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On March 1, 1996, the California Air Resources Board established regulations mandating the use of reformulated or so-called "Phase 2" gasoline in California in order to reduce air pollution. Unocal was in the business of making, using, selling and offering for sale this reformulated gasoline. On December 14, 1996, Unocal sold its business of refining and marketing reformulated gasolines to Tosco. Unocal retained the '393 patent and granted Tosco a license under the '393 patent to manufacture this reformulated gasoline.

On April 30, 1997, Talbert Fuel Systems, Inc., believing that Defendants were manufacturing gasoline that infringed the '356 patent, sent letters to Defendants Unocal and Tosco offering licenses of the '356 patent. Neither of the defendants responded to the letter. On January 16,1998, Talbert filed the instant action alleging three counts: (1) Direct Patent Infringement by Unocal; (2) Direct Patent Infringement by Tosco; and (3) Interfering Patents. The case was assigned to Judge Wardlaw. Both defendants filed an answer and a counterclaim for declaratory judgment seeking a determination that the '356 patent is invalid and that Talbert is estopped from attempting to collect royalties under the '356 patent against defendants. On March 18, 1998, Defendants filed a motion to dismiss pursuant to 12(b)(1) and for limited claim construction. On July 28, 1998, plaintiff filed a motion for claim construction. Judge Wardlaw had not addressed either motion at the time she was appointed to the Ninth Circuit. On September 11, 1998, the case was reassigned to this Court.

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III. DISCUSSION

A. Defendants' 12(b)(1) Motion to Dismiss

Defendants claim that this Court does not have subject matter jurisdiction over count three of Plaintiff's complaint for "interfering patents." This third claim alleges that Talbert's '356 patent and the '393 are interfering patents within the meaning of 35 U.S.C. §291, and seeks to invalidate the '393 on those grounds. Section 291 provides that "the owner of an interfering patent may have relief against the owner of another by civil action, and the court may adjudge the question of any of the interfering patents, in whole or in part." 35 U.S.C. §291. However, a court does not have subject matter jurisdiction to judge the validity of a patent where a plaintiff cannot establish that "interference" exists. *Albert v. Kevex Corp.*, 729 F.2d 757, 760-61 (Fed. Cir.), reh'g denied, 741 F.2d 396 (Fed. Cir. 1984).

In order for a court to find interference, a party must establish "substantial identity" between the claims of the patents. *Id.* Under this standard, all limitations of a claim are material. Defendants argue that although the inventive concepts of the patents are similar, the two claims at issue contain different limitations and thus are not interfering.[1] In order to evaluate whether the patents are interfering, this Court must engage in a limited claim construction of the '356 patent.

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1. The parties agree that plaintiff's claim of "interfering patents" is directed specifically to claim 1 of Talbert's '356 patent and claim 81 of the '393 patent. The parties further agree that the language of claim 81 is sufficiently clear as to preclude the need for the Court to engage in a formal claim construction of the '393 patent.

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B. Claim Construction of '356 Patent

Claim construction is a matter of law for the trial court. *Markman v. Westview Instruments, Inc.*, 116 S. Ct. 1384, 1393 (1996). "It is well-settled that in interpreting an asserted claim, the court should look to the intrinsic evidence of record, i.e. the patent itself, including the claims, the written description portion of the specification and, if in evidence, the prosecution history. Such intrinsic evidence is the most significant source of the legally operative meaning of disputed claim language." *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996) (citations omitted). Courts must be careful to merely understand and explain the scope of the patent, and not to transform or expand that scope during construction. *Scripps Clinic & Res. Found. v. Genetech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991).

1. Intrinsic Evidence in the Record

Talbert claims that the '393 and '356 patents embody the same inventive concept by a different name. However, a claim under §291 requires identical "claims" in a patent, not identical "inventive concepts." *Advance Transformer Co. v. Levinson*, 837 F.2d 1081, 1083-84 (Fed. Cir. 1988). Both patents cover novel fuel compositions which reduce the content of low and high end hydrocarbons from conventional gasoline. Defendants' patent describes the concept in terms of the gasoline's physical properties, specifically its distillation characteristics ("boiling points"), while Plaintiff's concept is described primarily in terms of its hydrocarbon speciation. Plaintiff contends that these are merely two methods of identifying an identical gasoline composition.

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Defendants maintain that the express limitations contained in Unocal's patent (e.g. T50, T10, T90, paraffin volume percent, olefin volume percent, octane, unleaded motor gasoline), create material differences that preclude a finding of interfering patents under §291. Defendants' primary basis for differentiating the two patent claims, however, is that the '356 patent includes a restrictive range of boiling points, while the '393 patent contains no such restriction.

a. Language of the '356 Claim

Defendants contend that Talbert's patent encompasses only a gasoline with a boiling point range of 121-345° F. Talbert disagrees, stating that the language in their claim that describes a "gasoline having a boiling point range between 121° F and 345° F" was merely illustrative and is not limiting language. Under Talbert's interpretation, the '356 patent also covers a gasoline with boiling points below or above the stated range, depending upon the existence of low end primers and residual high end components. Talbert believes that its patent specifically allows for such low and high end components because its claim recitation describes a gasoline "consisting essentially of . . ." mid range hydrocarbons but allowing for residual low and high end components that may be left behind "due to imperfections in current fractionation techniques." (Col 6, lines 7-12). However, contrary to Talbert's arguments, the clear language of claim one describes the following composition:

> a "gasoline comprising a priming agent and a hydrocarbon mixture having intermediate carbon range relative to C4-C12 fuel; said intermediate carbon range consisting essentially of C6-C10

> hydrocarbons with C9 and C10 paraffinic hydrocarbons being present in the mixture; *said gasoline* having a boiling point range of 121°F - 345°F at 1 atmosphere pressure . . ."

(emphasis added). Talbert chose to explicitly include a "range" of boiling points and to specify the type of high end hydrocarbons included in his middle cut blend - paraffinic C10 hydrocarbons; whose highest boiling point is 345° F. These explicit limitations included in the claim clearly indicate that the patent covers a hydrocarbon composition fuel with an end point of 345 °F.

b. Talbert's Prosecution History

A review of the prosecution history confirms this court's interpretation of the claim language. In construing the '356 patent, the Court may consider representations and arguments made to the examiner, including those in related applications. See *Jonsson v. Stanley Works*, 903 F.2d 812, 818 (Fed. Cir. 1990). Talbert's prosecutions of applications 463,251, 638,069, and 941,833 involved very similar parent fuels of the '356 fuel.[2] In prosecuting these early applications before the Patent and Trademark office, Talbert distinguished his fuels from prior art by highlighting that his middle cut gasoline blend had a final boiling point of 345 degrees.[3] Similarly, in the prosecution of

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2. Although some of these applications addressed gasifier fuels, Talbert has conceded that the standard carburetor gasoline is the same as his gasifier composition, except for a small amount of priming agent. See '356 patent, Col. 9, l. 19-22.

3. See e.g. Def's Appendix, Exhibit A, pp. 2, 53; Exhibit C, pp. 174, 182; Exhibit F, p. 372.

the '356 patent, Talbert stated that "it will be noted that applicant's fuel which contains C9 and C10 hydrocarbons has a final boiling point of 345° Centigrade (sic) which corresponds to the boiling point of C10 paraffinic hydrocarbon." (Tab 16, '356 file History Amendment under Rule 312(a), January 9, 1990.). Therefore, regardless of Talbert's qualifying modifiers, the Court-finds that the language of the claim, the specifications and the prosecution history reveal that the '356 patent covers a gasoline with a high end boiling point of 345° F. See *Ekchian v. Home Depot, Inc.*, 104 F.3d 1299, 1304 (Fed. Cir. 1997); *Vitrionics*, 90 F.3d at 1582

2. Extrinsic Evidence

Reliance on extrinsic evidence to interpret claims is proper only when claim language "remains genuinely ambiguous after consideration of the intrinsic evidence." *Bell & Howell Document Mgmt. Prod. Co. v. Altek Systems*, 132 F.3d 701, 706 (Fed. Cir. 1997). Such evidence should be used only to aid the court in "coming to the proper understanding of the claims" and the technology involved. *Vitronics*, 90 F.3d at 1583. The Court finds that the language of the '356 claim is unambiguous, and thus the Court need not refer to extrinsic evidence to resolve the issues involved in these motions.

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IV. CONCLUSION

Based upon the analysis above, the Court finds the '356 patent to claim a liquid gasoline with an RVP between 6-9 psi; to claim a carbon range of C6-C10 hydrocarbons, which includes a range of true boiling points from 121° F to 345° F and which allows for the presence of a C4 and C5 priming agent. Unocal's '393 patent contains no such limitation on distillation characteristics. In addition, the '393 patent's specific olefin and paraffin limitations further distinguish it from the composition proscribed by the '356 patent. These distinctions preclude a finding of interfering patents under §291. Accordingly, this Court DISMISSES WITH PREJUDICE claim number three of Plaintiff's complaint for lack of subject matter jurisdiction.

IT IS SO ORDERED.

DATE: 12/11/98

s/ Consuelo B. Marshall
CONSUELO B. MARSHALL
UNITED STATES DISTRICT JUDGE

APPENDIX G — ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DENYING PETITION FOR REHEARING DATED AND FILED MARCH 15, 2002

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

99-1421

TALBERT FUEL SYSTEMS PATENTS CO.,

Plaintiff-Appellant,

v.

UNOCAL CORPORATION,
UNION OIL COMPANY OF CALIFORNIA,

Defendants-Appellees,

and

TOSCO CORPORATION,

Defendant-Appellee.

ORDER

A combined petition for panel rehearing and for rehearing en banc having been filed by the APPELLANT, and the petition for rehearing having been referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

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ORDERED that the petition for panel rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the petition for rehearing en banc be, and the same hereby is, DENIED.

The mandate of the court will issue on March 22, 2002.

FOR THE COURT,

s/ Jan Horbaly
Jan Horbaly
Clerk

Dated: March 15, 2002